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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,222	09/17/2003	Matt Nordstrom	05127.00228	6277
22908 7590 04/06/2007 BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			EXAMINER OSELE, MARK A	
			ART UNIT 1734	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			04/06/2007	
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/665,222	Applicant(s) NORDSTROM, MATT	
	Examiner Mark A. Osele	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 6, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-12, 14-20 and 22-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-12, 14-20 and 22-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-4, 7-12, 14-20, 22-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 1, the originally filed specification and disclosure fail to show the second and third textile elements as well as the adhesive element to have substantially similar dimensions yet the bond between the third textile element and the adhesive having an unbonded area between them as well as a bonded area with the bonded area being in a spaced relationship with at least some of the outer edges of the third textile element. The specification does teach that the bond between the second and third textile elements can be spaced from the edges of the third textile element, but this is only practical when the third textile element is larger in dimension than the second textile element, such as shown in Figs. 13-15, not when the second and third elements are the same size as in the currently amended claims.

Regarding claim 16, the originally filed specification and disclosure fail to show the first textile element having a greater area than the second textile element as well as

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the bond being in a spaced relationship with at least some of the outer edges of the second textile element. The specification does teach the above claimed dimensions of the first textile element, 60, and the second textile element, 30d, but with the bond being in a spaced relationship with at least some of the outer edges of the first textile element in Figs. 13-15.

Regarding claims 24 and 34, although the originally filed drawings show the instantly claimed invention wherein the second textile element is bonded only at the outer perimeter to the first textile element, the originally filed specification does not describe this. The specification should be amended to fully describe the newly amended claims with care being taken to ensure that no new matter is added to the specification that was not in the originally filed specification or drawings.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4, 7-12, 14-20, and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 claims in lines 7-8 that the "the first textile element to have a greater area than the second textile element, the third textile element, and the adhesive element." It is unclear whether this means that the first textile element has a greater area than any of the second textile element, the third textile element, and the adhesive element, or whether the first textile element has a greater area than the summation of the areas of the second textile element, the third

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textile element, and the adhesive element. Claim 16 claims in lines 5-6 that the “the first textile element having a greater area than the second textile element and the adhesive element.” It is unclear whether this means that the first textile element has a greater area than either of the second textile element and the adhesive element, or whether the first textile element has a greater area than the summation of the areas of the second textile element and the adhesive element.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 8, 10-14, 16-19, and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Stahl (5,422,173). Stahl '173 teaches a method of joining a plurality of textile elements to make an article comprising the steps of: providing a first bond between a third textile element, 26, and an adhesive element, 24; forming a second bond between a second textile element, 22, and the adhesive element by applying heat and pressure between platens (column 3, lines 57-63); and attaching the joined second and third textile elements to a first textile element (column 5, lines 11-24), wherein the bond between the second and third textile elements is in a spaced relationship with the outer edges of the third textile element (Fig. 2).

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Regarding claims 5-6, the first bond is located in a spaced relationship with all outer edges of the second textile element (Fig. 2).

Regarding claims 13 and 21 the second and third textile elements have substantially similar dimensions (Fig. 2).

Regarding claims 14 and 17-18 the adhesive element is a thermoplastic polymer such as urethane or polyester (column 3, lines 18-19).

Regarding claim 16, the disclosure of Stahl also anticipates the limitations wherein element 26 is the first textile element, element 22 is the second textile element which is bonded to first textile element in a spaced relationship with some of the outer edges of the second element.

The above rejection is directed to the claims without the newly added new matter limitations.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl (5,422,173) in view of Mahn, Sr. et al. (4,971,644). As shown in paragraph 2

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above, Stahl shows all of the claimed limitations except for the textile element and garment to be made of a mesh material. Mahn, Sr. et al. teaches that sports jerseys are commonly made from a mesh material and it is desirable to have a number applied to the jersey. Furthermore, Mahn, Sr. et al. teaches that numbers that cover the holes in a mesh jersey are aesthetically unappealing and block air flow (column 1, lines 48-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the garment and the textile element of Stahl of a mesh material because Mahn, Sr. et al. teaches that mesh garments and applied emblems are desirable for sport uniforms.

The above rejection is directed to the claims without the newly added new matter limitations.

5. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl in view of either Conrad (3,662,878) or Castro, Jr. (5,906,006) As shown in paragraph 2 above, Stahl shows all of the claimed limitations except for the textile element to be sewn on a garment. Conrad (column 1, lines 23-26) and Castro, Jr. (column 2, lines 31-38) each teach that adhesive bonding or sewing are known for putting a textile element on a garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sew the textile element of Stahl on

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a garment because Conrad and Castro, Jr. each teach this to be a conventional alternative to adhesive bonding.

The above rejection is directed to the claims without the newly added new matter limitations.

Response to Arguments

6. Applicant's arguments with respect to claims 1-4, 7-12, 14-20, and 22-42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Osele whose telephone number is 571-272-1235. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MARK A. OSELE
PRIMARY EXAMINER

April 1, 2007